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09/884,506	06/14/2001	Tidhar D. Shalon	IN-0012-4	3499

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EXAMINER

LUDLOW, JAN M

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/884,506

Applicant(s)

SHALON ET AL.

Examiner

Jan M. Ludlow

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1743

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

2. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

3. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5, 8-18 are rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1-41 of U.S.

Patent No. 6309891 in view of Little et al. The claims of the patent teach the limitations of the instant claims with the exception of a positioner. Little teaches a dispenser similar to that of the patent. An XYZ positioner is provided for moving the dispenser into printing position relative to the substrate. It would have been obvious to provide a positioner in the device of the patented claims in order to move the dispense head into position as taught by Little.

5. Claims 6-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 12 of copending Application No. 09/819162. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claim language is not identical, the limitations of the instant claims are encompassed by the copending claims.

Art Unit: 1743

6. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In claims 6-7 "wire bonding capillary" is indefinite because it is unclear what structural limitations are intended by "wire bonding"—is a particular material of construction, dimensional limit or other feature required which defines a wire bonding capillary over any other capillary?

9. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Little et al ('925).

10. Little teaches method and apparatus for preparing arrays by dispensing low volume droplets on a substrate. Capillary needles 62 with bores open at both ends are provided in a pin block. Biasing springs 74 restrict motion. The needles can be made of steel, silica, polymers, or any other suitable material (bridge cols. 7-8). A robotic system is used to move the pin block to a source plate containing wells (larger than a capillary and in fluid contact with the capillary), and then to the substrate, which can be silicon, plastic, metal or any suitable material, flat or pitted (col. 9, lines 10-17).

Solutions of DNA can be dispensed, and the capillaries may be filled by capillarity (col. 9, lines 40-65)

11. Little fails to explicitly teach "printing".

Art Unit: 1743

12. It would have been obvious to one of ordinary skill in the art to provide the small volumes of solution to a flat surface as taught by Little. It is the examiner's position that such dispensing constitutes "printing" as used in the instant application. With respect to "wire bonding capillary" in that applicant has disclosed no special properties of wire bonding capillaries defining over ordinary capillaries, it is the examiner's position that the capillaries of Little are structurally capable of use as wire bonding capillaries and/or constitute wire bonding capillaries to the extent the term is definite.

13. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feygin. (59 57,167)

14. Feygin teaches a method and apparatus for printing biological substances on a substrate. A capillary tube with a slit in it (slit not precluded by the instant claims) can be decelerated to print a droplet (col. 3, line 23). A spring biasing device is shown in Figure 3. Plural dispensing members and automated operation are taught (col. 5, lines 55-65). With respect to reservoirs, the upper end of the capillary is a reservoir; alternatively, the source well into which the capillary device is dipped for loading is a non-capillary reservoir in fluid contact with the capillary during loading.

15. Feygin fails to explicitly teach open capillary bore ends open to atmosphere.

16. It would have been obvious to provide the capillary tube embodiment in the device of Figure 6 in order in order to deliver fluids as taught by Feygin. Note that a capillary tube is inherently open at both ends and the device of Figure 6 does not cover the end of the printing tube. It would have been obvious to provide positioners and other known moving expedients in order to automate the system as taught by Feygin. It

Art Unit: 1743

would have been obvious to make the heads replaceable in order to remove damaged or contaminated heads as was known in the printer and pipetting art. With respect to "wire bonding capillary" in that applicant has disclosed no special properties of wire bonding capillaries defining over ordinary capillaries, it is the examiner's position that the capillaries of Feygin are structurally capable of use as wire bonding capillaries and/or constitute wire bonding capillaries to the extent the term is definite. Element 618 constitutes the instant nozzle surface. It would have been obvious to make the gang of devices of a single material for reproducibility of delivery, and of known materials for their known strength and inertness. It would have been obvious to space the devices for insertion into known well plates. With respect to "wire bonding capillary" in that applicant has disclosed no special properties of wire bonding capillaries defining over ordinary capillaries, it is the examiner's position that the capillaries of Feygin are structurally capable of use as wire bonding capillaries and/or constitute wire bonding capillaries to the extent the term is definite.

17. Claims 1-2, 8-11, 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feygin as applied to claims 3-7 above and further in view of Thomas.
18. Feygin fails to teach the preservative.
19. Thomas teaches a reagent transfer device having a resilient rubber pad which is abutted with the transfer device outlet opening to prevent evaporation from the device during storage (col. 3, lines 59-64).

Art Unit: 1743

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an evaporation prevention device such as a rubber pad for abutting the capillary openings in the device of Feygin in order to prevent evaporation of reagents from the openings during storage as taught by Thomas.

21. Claims 12, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feygin and Thomas as applied to claims 1-2, 8-11, 13-17 above and further in view of Brown.

22. Feygin fails to teach contacting the substrate.

23. Brown teaches a method similar to that of Feygin, but the deceleration includes tapping or contacting the tip with the substrate.

24. It would have been obvious to contact the tip of Feygin to the substrate as taught by Brown if one were willing to forego the advantage of tip and substrate damage taught by Feygin.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (703) 308-4039. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Art Unit: 1743

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jan M. Ludlow  
Primary Examiner  
Art Unit 1743

jml  
June 30, 2003